

REMARKS

In accordance with the foregoing, the specification and claim 1, 6, 7, 8, 11, 12, 13, 14, 15, and 16 have been amended. Claims 9 and 10 have been cancelled without prejudice or disclaimer. New claims 17 and 18 have been added. Support for new claims 17 and 18 may be found in claims 9 and 10 as filed originally. Claims 1-8 and 11-18 are pending and under consideration.

Support for the amendments to the claims may be found in the claims as originally filed. Reconsideration is requested based on the foregoing amendment and the following remarks.

Objections to the Specification:

The Specification has been objected to for an informality. Appropriate corrections were made. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 101:

Claims 9 and 10 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 9 and 10 have been cancelled, so the rejection is believed to be moot.

Double Patenting:

The Office Action asserted that if claim 11 were allowed, claim 12 would be rejected as being a substantial duplicate of claim 11. Claims 11 and 12 have been amended, and are submitted to now be of different scope.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 2, 3, 6, 7, and 11-15 were rejected under 35 U.S.C. § 102(b) as anticipated by Kikinis, US 5,929,849 (hereinafter "Kikinis"). The rejection is traversed to the extent it would apply to the claims as amended.

Claim 1 recites, in pertinent part:

"reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information."

Kikinis neither teaches, discloses, nor suggests reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus

read-out program information, as recited in claim 1. In Kikinis, rather, a set-top box 11 combines programs to be broadcast from the station and information from the internet. Set-top box 11 further inserts data showing the position and region of an object to be displayed on a display monitor in regions between adjacent frames, together with information such as a URL, so that the user at the information receiver terminal can extract advertisements in connection with the object the user has selected, as described at column 8, lines 61-64. This is to be contrasted with claim 1, which recites reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information.

Furthermore, Kikinis shows no forming of information related to each object. Nor does Kikinis show generation of sync-information for synchronizing the program information with the relevant information with reference to an object extraction table and the related information data. Nor does Kikinis store the generated sync-information in a sync-information monitoring table.

Claim 1, in particular, recites further:

“extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.”

Kikinis neither teaches, discloses, nor suggests extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen, as recited in claim 1.

Finally, claim 1 recites,

“generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table.”

Kikinis neither teaches, discloses, nor suggests generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table, as recited in claim 1. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2 and 3 depend from claim 1 and add further distinguishing elements. Claims 2 and 3 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2 and 3 is also earnestly solicited.

Rejection of Claim 6:

Claim 6, recites,

“reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information.”

Kikinis neither teaches, discloses, nor suggests reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information, as recited in claim 6.

Claim 6 recites further,

“extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.”

Kikinis neither teaches, discloses, nor suggests extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen, as recited in claim 6.

Claim 6 recites further,

“generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table.”

Kikinis neither teaches, discloses, nor suggests generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table, as recited in claim 6.

Finally, claim 6 recites,

“generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object.”

Kikinis neither teaches, discloses, nor suggests generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object, as recited in claim 6. The fact that a sports organization may also present season ticket prices and the like, and even accomplish sales of Internet links, has nothing to do with recruiting a sponsor directly to the owner at the receiver side. Claim 6 is submitted to be allowable. Withdrawal of the rejection of claim 6 is earnestly solicited.

Rejection of Claim 7:

Claim 7 recites,

“sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information including the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed.”

Kikinis neither teaches, discloses, nor suggests sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information includes the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed, as recited in claim 7.

Claim 7 recites further,

“storing the received program information, relevant information, and sync information.”

Kikinis neither teaches, discloses, nor suggests storing the received program information, relevant information, and sync information, as recited in claim 7.

Finally, claim 7 recites,

“synchronously outputting the program information and relevant information in accordance with the stored sync information.”

Kikinis neither teaches, discloses, nor suggests synchronously outputting the program information and relevant information in accordance with the stored sync information, as recited in claim 7. Claim 7 is submitted to be allowable. Withdrawal of the rejection of claim 7 is earnestly solicited.

Rejection of Claim 11:

Claim 11 recites,

“reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information.”

Kikinis neither teaches, discloses, nor suggests reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information, as recited in claim 11.

Claim 11 recites further,

“extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.”

Kikinis neither teaches, discloses, nor suggests extracting an object appearing in a program which is to be broadcast to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen, as recited in claim 11.

Finally, claim 11 recites,

“generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table.”

Kikinis neither teaches, discloses, nor suggests generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table, as recited in claim 11. Claim 11 is submitted to be allowable. Withdrawal of the rejection of claim 11 is earnestly solicited.

Rejection of Claim 12:

Claim 12 recites,

“generating the sponsor-recruiting information for recruiting a sponsor who pays for the cost of displaying the extracted object.”

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the Office Action at page 7. No transmitter means no generator. Claim 12 is submitted to be allowable. Withdrawal of the rejection of claim 12 is earnestly solicited.

Rejection of Claim 13:

Claim 13 recites,

“an object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen.”

Kikinis neither teaches, discloses, nor suggests an object extraction unit which extracts an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on

a screen, as recited in claim 13.

Claim 13 recites further,

“a relevant-information generation unit which generates the relevant information about the object extracted by said object extraction unit, which is carried out principally with reference to said object extraction table.”

Kikinis neither teaches, discloses, nor suggests a relevant-information generation unit which generates the relevant information about the object extracted by said object extraction unit, which is carried out principally with reference to said object extraction table, as recited in claim 13.

Finally, claim 13 recites,

“a sync-information generation unit which generates the sync information for synchronizing the program information with the relevant information.”

Kikinis neither teaches, discloses, nor suggests a sync-information generation unit which generates the sync information for synchronizing the program information with the relevant information, as recited in claim 13. Claim 13 is submitted to be allowable. Withdrawal of the rejection of claim 13 is earnestly solicited.

Rejection of Claim 14:

Claim 14 recites,

“a sponsor-designating-information receiver which receives the sponsor-designating information for designating that the owner of the receiving unit becomes the sponsor who pays for the cost of displaying the object to said receiving unit.”

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the Office Action at page 7. No transmitter means no receiver. Claim 14 is submitted to be allowable. Withdrawal of the rejection of claim 14 is earnestly solicited.

Rejection of Claim 15:

Claim 15 recites,

“sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information including the information about the time at which the object is displayed or the frames that contain the object, and the information about the

display position at which the object is displayed.”

Kikinis neither teaches, discloses, nor suggests sync information for synchronizing the program information with the relevant information from said broadcasting unit, said sync information includes the information about the time at which the object is displayed or the frames that contain the object, and the information about the display position at which the object is displayed, as recited in claim 15. Claim 15 is submitted to be allowable. Withdrawal of the rejection of claim 15 is earnestly solicited.

Rejection of Claim 1, 4, and 5:

Claims 1, 4, and 5 were rejected under 35 U.S.C. § 102(e) as anticipated by Walker et al., US 6,131,086 (hereinafter “Walker”). . The rejection is traversed to the extent it would apply to the claims as amended.

Walker neither teaches, discloses, nor suggests reading program information from a program-information database provided in said broadcasting unit and image-analyzing the thus read-out program information, as recited in claim 1.

Walker neither teaches, discloses, nor suggests extracting an object appearing in a program which is to be broadcast so as to generate an object extraction table in accordance with the information of the time or frame and display position of the object on a screen, as recited in claim 1.

Walker neither teaches, discloses, nor suggests generating the relevant information about the extracted object, which is carried out principally with reference to said object extraction table, as recited in claim 1. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 4 and 5 depend from claim 1 and add further distinguishing elements. Claims 4 and 5 are thus also submitted to be allowable. Withdrawal of the rejection of claims 4 and 5 is also earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 8 and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Kikinis. The rejection is traversed. Reconsideration is earnestly solicited.

Claim 8 recites, in pertinent part:

“transmitting sponsor-designating information to the broadcasting unit for designating

that the owner of the receiving unit becomes the sponsor who pays for the cost of displaying the object to said broadcasting unit."

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the Office Action at page 7. The Office Action seeks to compensate for this deficiency of Kikinis by taking Office Notice that transmitting a purchase confirmation to a user is well known in the art. A rejection under 35 U.S.C. § 103(a), as explained in the M.P.E.P. §706.02(j)(D), however, requires more than an assertion that an element was known at the time the invention was made. In particular,

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: . . .

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. M.P.E.P. § 706.02(j)(D).

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See In re Rouffet, 47 USPQ2d at 1457.

If identification of each claimed element in the prior art were sufficient to negate patentability, the Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the Office action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

Many things may have been well known *individually* at the time of the invention. A rejection under 35 U.S.C. § 103(a) requires a showing that the *combination* of elements was obvious, *i.e.*, a showing that persons of ordinary skill in the art at the time the invention was made would have seen fit to form the claimed *combination*. Here, the Office Action has pointed to no teaching, either in the cited references or the general state of the art, as to why one of

ordinary skill in the art at the time the invention was made would have been motivated to modify Kikinis to form the claimed combination, beyond an assertion that transmitting a purchase confirmation to a user is well known in the art. Claim 8 is submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Rejection of Claim 16:

Claim 16 recites, in pertinent part:

"a sponsor-designating-information transmission unit which transmits the sponsor-designating information for designating that the owner of the receiving unit becomes a sponsor for paying the cost of displaying the object to said broadcasting unit."

Kikinis fails to disclose transmitting sponsor-designating information for designating that the sponsor becomes a sponsor for the object to said broadcasting unit, as acknowledged graciously in the Office Action at page 7. Here, the Office Action has pointed to no teaching, either in the cited references or the general state of the art, as to why one of ordinary skill in the art at the time the invention was made would have been motivated to modify Kikinis to form the claimed combination, beyond an assertion that transmitting a purchase confirmation to a user is well known in the art, as discussed above with respect to the rejection of claim 8. Claim 16 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 8. Withdrawal of the rejection of claim 16 is earnestly solicited.

New Claims 17 and 18:

Claims 17 and 18 are supported by the disclosure of original claims 9 and 10, which were asserted to be directed to non-statutory subject matter. Claims 17 and 18 are submitted to be directed to statutory subject matter, and are believed to be allowable.

Conclusion:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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